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RemarksUSC § 102 Rejection

## A. Summary to date:

Claims 1-2, 6-7, 11-12, 15, 17-19 and 26-28 remain rejected under 35 USC 102(b) over Israel (US 4,887,409). In the first two office actions the Examiner maintained that extruded powders are not patentably distinct from pressed powders and that the recitation of extruded powder in claim 1 is met by the disclosure of pressed powder in the Israel patent (US 4,887,409). In two replies, the applicant expounded on the differences between pressed powder and extruded powder, drawing on the specification as filed, as well as on that which was known by a person of ordinary skill in the art at the time the invention was made.

In the office action dated June 2, 2003 (paper #9) the Examiner attempted to argue as follows:

Applicant has argued the difference in compositions of extruded powders and pressed powders; however, Applicant fails to show the different amounts of binders used in pressed and extruded powders...The only difference between the final extruded powder and pressed powder appears to be a degree of binder used and the disclosure is not specific as to what this difference in the degree of binder used is; without this teaching the degree of binder used is broadly claimed and is held to be met by the prior art.

In reply, the applicant pointed out that there was no reason for the Examiner to assume that the only difference between pressed and extruded powders is the level of binder used in making the powders. Furthermore, even if that was the only compositional difference (and it isn't), that difference in composition could and does result in dramatic differences in the final product so that extruded powders are unlike pressed powders to a substantial degree and in a number of ways, which are expounded upon in the specification and in previous replies by the applicant. An analogy was drawn to the dramatic differences between various grades of iron and steel, although their chemical compositions are greatly similar. The applicant went on to assert further, that a person of skill in the art at the time the invention was made readily recognizes and understands the differences between pressed powder or extruded powder and that, by itself, makes them patentably distinct, generally. Finally, the

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applicant asserted that the Examiner had provided no evidence to support her position that an extruded powder should ever be anticipated by a pressed powder, merely an unsupportable assertion that the only difference between them is in the level of binder used and that that difference could be ignored for patentability. Applicant then went on to discuss the differences in the two powder forms as outlined in the specification. Generally, these differences as discussed in the specification included: chemical composition, including the limitations placed on chemical composition by the different manufacturing steps of pressing verses extruded; and the very different physical properties of the final powder products.

In the Advisory action dated August 27, 2003 (paper #12) the examiner did not dispute that the specification elaborates on the differences between pressed and extruded powers, but she did consider the applicant's comments unpersuasive, saying:

The terms pressed powder and extruded powder are used interchangeably in the art and cannot be used to distinguish over each other (see US patent 3,800,034, col. 1, lines 10,49; US Patent 4,925,667, col. 2, lines 20+ which refer to the process of 4,337,859 as an extruding process while the '859 patent refers to the process as a pressed powder process.

And that is where it lies.

B. The above statement in the Advisory Action is the first presentation of this line of reasoning by the Examiner. Clearly it is a response to the applicant's assertions that persons of ordinary skill in the art do understand pressed powder and extruded powder differently. Furthermore, it is the only statement made by the examiner in the Advisory Action. May the applicant assume that the Examiner is now convinced that the specification as filed describes various differences between pressed and extruded powders, not just a difference in binder level. Also, may the applicant understand the Examiner's silence in the Advisory Action as acknowledgment that even minor differences in one ingredient can and do lead to significantly different, patentably distinct products? Assuming this is so, all that is left to do is to demonstrate that the Examiner's assertions are wrong, concerning what a person of ordinary skill in the art would understand. Turning to the cited references.

1. US patent 3,800,034, col. 1, lines 10,49 (the Kircher patent). Column 1, line 10 refers to a "dry pressed powder stick". Column 1, line 49 refers to an extruded stick

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which is allowed to dry after being extruded. Taken together, the Examiner maintains that Kircher uses pressed powder and extruded powder interchangeably. But this conclusion can only be reached by not reading the whole document and by combining portions out of context.

Column 1 line 10 identifies the invention as a pressed powder stick, as do lines 40-41. Column 1, lines 44 to 49 disclose that in the preferred embodiment, the stick is formed by extrusion. This is repeated in column 3, lines 9-10.

However, column 2, lines 48-51 disclose that the sticks of the invention may be "formed" by means other than extruding. And column 3, lines 35-39 disclose that sticks of the invention may be formed **"by pressing or molding operations rather than extrusion"**.

Therefore, even though column 1, line 10 and column 1, line 49 seem to indicate that "extruded" and "pressed" are used interchangeably, it is now clear that they are not interchangeable. Kircher, when read for all it discloses, makes separate reference to extruded powder sticks and pressed powder sticks. The paragraphs that start at column 2, line 48 and column 3, line 9 are critical to understanding this. Therein, the patentee explains differences in formulation that should be observed if one is going to extrude rather than press or mold the powder stick of the invention. So in this reference, the inventors are highlighting differences between pressed and extruded powders of the same invention. The extruded powder absolutely requires a lubricant and has two to three times as much water as a pressed powder. The presence of a lubricant and the drastic difference in water content generally lead to quite distinguishable end products.

Kircher invented a powder formulation that included binder that would make sticks of the formulation superior to the prior art. In that respect, it did not matter if the stick was made by extrusion or pressing, either way the sticks of Kircher were superior to prior art sticks. But what does matter is that Kircher also discloses differences within the embodiments of his own invention depending on whether its is executed by extrusion or pressing.

Finally, although the foregoing should suffice to negate Kircher as a supporting reference, it must be noted that the reference was written in 1970. On its face, the Kircher reference may be the first reference, but is certainly a very early reference to

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extruded powders. In discussing the prior art, the Kircher reference mentions grease sticks and pressed powder sticks, but it makes no mention of extruded powder sticks. The point is, that extruding a powder was new. And when reading only portions of Kircher, out of the context of the whole, some of the language used may seem to obscure the differences between pressed and extruded powders. The field was new and the language of the field was new. Today, over thirty years have elapsed and the art of extruded powders has not remained static. When applicant maintains that a person of ordinary skill in the art understands the art recognized differences between pressed and extruded powders, it is axiomatic that the applicant means a person of skill in the art at the time the invention was made, not thirty years ago.

2. US Patent 4,925,667 (the Fellows patent), col. 2, lines 20- 28 refer to the process of 4,337,859 as a process of making a molded cosmetic powder cake by extruding into a mold and letting the formulation cool and solidify.

Regarding US patent 4,337,859 (the Murphy patent), the Examiner has not told the applicant where to look for a "pressed powder process". In fact, this is a case of completely missing the mark. There is no disclosure of pressed powders in Murphy, except in discussing the prior art and why pressing is bad. In contrast, the point of Murphy's invention is to get away from pressing because it places limitations on what the powder formulation may be, the exact argument made by the applicant in demonstrating that there art recognized differences between pressed and extruded powders. To say one or the other conjures, in the mind of a person of ordinary skill in the art, differences in formulation and differences in physical properties. The Murphy reference, when properly read, makes the applicant's case! The only disclosure of pressed powders in Murphy is to distinguish Murphy's extruded, molded powder from them. See for example, column 1, lines 64-66:

By using the slurry technique [i.e. extrusion] for forming the powder cake, finely divided materials, **not capable of being successfully compressed**, can be used to form a cake.

Here's an example then, where finely divided materials which cannot be formulated into pressed powders may be formulated into extruded powders. Certainly, Murphy supports the applicant's position and not the Examiner's.

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Therefore, pressed and extruded powders have many differences, in composition and physical properties and persons of ordinary skill in the art use the terms differently. That being said, claim 1 is novel over Israel because Israel does not recite all of the elements of claim 1.

To constitute an anticipation, a reference must contain **each and every element** of the rejected claim within its teachings; absence of a claim element from a prior art reference **negates** anticipation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ 409 (Fed. Cir. 1984).

It is well established that a rejection for anticipation under section 102 requires that **each and every** limitation of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994).

Israel makes no mention of an extruded powder, let alone an extruded powder disposed in a groove. Israel at great length describes the flowable powders being loaded into a pan and subsequently pressed to give the powder firmness. But, as discussed, pressed powders are not the same as extruded powders. Based on the absence of extruded powders in Israel, Israel does not anticipate the present invention. Applicant requests reconsideration of this rejection. Since claim 1 is not anticipated by Israel, neither are dependent claims 2-28. However, regarding claim 27, applicant wishes to point out that Israel does not disclose a cover which is friction fit onto the surface. The cover 14 in Israel is secured by a fastener made up of detent 18 and slot 20. For this reason, claim 27 is further not anticipated by Israel.

### **35 USC § 103 Rejections**

A. Claims 3-5 stand rejected as being unpatentable over Israel in view of von Kleinsorgen. The Examiner wrote:

With regard to claims 3-5, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for the powders being not all the same color and chemical composition...Von Kleinsorgen discloses a cosmetic stick (fig. 1) comprising at least two powders (12, 13) being not all the same color and chemical composition (col. 4, lines 19-22)...It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the particular powder as taught by von Kleinsorgen into the case of Israel for the purpose of providing a plurality of different colors."

There are a number of flaws in the Examiner's statement. Firstly, Israel certainly does disclose powders of different colors (col. 1, lines 20-21; col. 2, line 8, col. 3, lines 54-55, col. 5, line 66 - col. 6, line 1) and/or different chemical compositions (col. 6, lines

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1-4). There is really no need to use von Kleinsorgen to introduce the concept of multiple colors or chemical compositions. This, however, proves to be irrelevant because the Examiner's initial statement, that Israel discloses the limitations of claim 1, has already been shown to be false, there being no extruded powders in Israel. Obviously then, even though von Kleinsorgen discloses multicolored powders and powders of different chemical compositions, claims 3-5 are still not rendered obvious. Notwithstanding the above, von Kleinsorgen does disclose "powder sticks" and applicant wishes to make some further remarks about the combination of Israel in view of von Kleinsorgen.

The combination does not teach all elements of claims 3-5

Firstly, the powder sticks of von Kleinsorgen are nowhere disclosed to be extruded powders and, as already noted, extruded powders are not disclosed in Israel. Therefore, the combination of Israel in view of von Kleinsorgen does not teach or suggest the extruded powders recited in claims 3-5. This alone negates the finding of obviousness, but other reasons exist as well.

The combination lacks motivation to combine or modify

The Examiner has not explained what the motivation would be to modify Israel with the teachings of von Kleinsorgen. In fact no such motivation exists. This is clear when the references are viewed in their entirety as it is the Examiner's responsibility to do. Why, after reading von Kleinsorgen, would a person of ordinary skill in the art replace the pressed powders of Israel with the powder sticks of von Kleinsorgen? The Examiner has not placed on the record any reasoned explanation. Furthermore, the references do not teach or suggest any advantage to combining Israel and von Kleinsorgen. Actually, when read for all they disclose, the references teach away from their being combined. The Israel reference itself teaches that his invention is suitable only for compressed powders:

The articles contemplated by the present invention generally are sold to consumers in small portable containers commonly referred to as "compacts" in which the cosmetic article is stored as a **compressed powder** prior to application to the surface of the skin. The cosmetic article may comprise ... any other known cosmetic material **susceptible of being formed and stored in compressed powder mode**. Even more particularly, the cosmetic articles contemplated comprise multiple segments of cosmetic material ... **reposing in individual pans...**" (col. 1, lines 9-21).

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In contrast, von Kleinsorgen teaches the advantages of powder sticks over compressed powders in pans.

...powder sticks or pencils which are used for decorative cosmetic purposes differ from the powder compacts or powder blocks insofar as a powder stick or pencil is used to apply the powder directly to the skin by rubbing the actual powder pencil against the surface of the skin.... A considerable advantage of powder pencils of that kind is that the powder material can be applied to the skin in a substantially more accurate and more finely controlled manner...

Clearly, von Kleinsorgen is specifically differentiating his powder sticks from compressed powders in pans, like those of Israel. Therefore, von Kleinsorgen teaches away from Israel. This is a very strong motivation not to combine the references.

The combination lacks expectation of success

Furthermore, there is no expectation of success because the proposed combination cannot be done successfully. The Examiner wrote:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the particular powder as taught by von Kleinsorgen into the case of Israel for the purpose of providing a plurality of different colors."

Employing "the particular powder as taught by von Kleinsorgen into the case of Israel" will not work. The essence of Israel is a process for filling and pressing loose powder in a single operation. The Examiner cannot simply ignore this portion of Israel. It is absolutely necessary for the Examiner to **consider the reference as a whole**. If you put the powder sticks of von Kleinsorgen into the filling and pressing machinery of Israel several things will happen. Firstly, the powder sticks will be destroyed so as not to be powder sticks anymore, rendering von Kleinsorgen inoperative for its intended purpose. In fact, if anything, the result will be the powder compacts and powder blocks from which von Kleinsorgen specifically differentiated his invention. Secondly, the powder sticks of von Kleinsorgen are comprised of stick portions of differing colors and chemical compositions stuck together. If such a powder stick is put into the machine of Israel, where it will be compressed and destroyed, the colors and formulae will be mashed together so that what comes out is not multiple powders of different colors and compositions but some unusable conglomerate. Also, the chemical compositions of von Kleinsorgen are suitable for powder sticks while those of Israel are suitable for compacts. A person of ordinary skill in the art will appreciate that these formulations have basic differences that make them suitable for their respective end use. Therefore,

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a person of ordinary skill in the art would not be expected to simply substitute the powder stick compositions of von Kleinsorgen into the compressed powder machinery of Israel.

In conclusion, when both references are read for all they disclose, it is clear that there is no meaningful way to combine Israel and von Kleinsorgen. The combination does not teach or suggest all of the elements of claims 3-5, the combination lacks motivation, as well as expectation of success. In fact, the references teach away from the combination and the office action fails to place on the record any reasoned statement in support of the combination. For these reasons, reconsideration of this rejection is respectfully requested.

**B.** Claims 8-9 and 13-14 stand rejected as being unpatentable over Israel et al in view of Schefer. The Examiner wrote:

With regard to claims 13-14, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above ...

Based on the foregoing discussion, the Examiner's initial position, that claim 1, from which claims 8-9 and 13-14 depend, is anticipated by Israel is incorrect. Therefore, when the Examiner relies on Schefer to introduce the additional elements of claims 8-9 and 13-14, the combination still fails to teach or suggest recited elements of claim 1. Specifically, the combination of Israel and Schefer fails to teach an extruded powder, let alone an extruded powder disposed in a groove. Differences between extruded and pressed powders have been discussed above, particularly noting that those differences suggest not to use an extruded powder in the manner revealed in the applicant's specification. Nothing in Schefer changes that fact. Schefer does not specifically say what are the physical forms of the cosmetics contemplated and therefore does not disclose an extruded powder. However, Schefer does require the cosmetic material 40 to be located in cosmetic inserts 24 (col. 3, lines 25-26). Regarding these inserts, the only embodiment disclosed in Schefer are pans of the type usually encountered in pressed powder cosmetic compacts, which, to the applicant's knowledge, are not necessary to hold extruded powders. Therefore, it must be understood that Schefer in no way contemplates doing what the applicant has done, i.e. disposing extruded powder in a groove. Since neither Israel nor Schefer alone or in



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combination discloses all the elements of claim 1, from which claims 8-9 and 13-14 depend, this rejection must be withdrawn.

Furthermore, claim 8 requires a portion of the powders to rise above the surface.

On this point the Examiner has written:

Schefer discloses a cosmetic compact case (fig. 6) comprising a surface (30) having a plurality of grooves, a portion of cosmetic powder (24) rises above the surface (fig. 6)...

Respectfully, the Examiner is mistaken in this observation. There are two possible interpretations. If surface 30 (called "recess 30" in Schefer) is interpreted as having grooves, then ribs 36 must be included as part of surface 30 because ribs 36 are what define the grooves or "areas" 38 into which the individual cosmetic inserts 24 are received (see col. 3, lines 15-17). If this is not done, then there is no way to say that surface 30 has grooves. However, when interpreted this way, then the cosmetic material 24 of Schefer does not rise above the surface, i.e. top edge of the ribs 36, which is clear in figure 6. Alternatively, if surface 30 is not interpreted to include ribs 36, then surface 30 does not have grooves. Furthermore, Israel does not disclose a portion of the powders rising above the surface. Therefore, in either interpretation of Schefer, claim 8 is not rendered obvious by the combination of Israel and Schefer.

Furthermore, claim 9 requires forty percent or more of each extruded powder to rise above the surface. On this point the Examiner has written:

...it would also have been an obvious matter to one having an ordinary skill in the art at the time the invention was made to construct forty percent or more of each powder rises above the surface, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

The Examiner is misguided, here, as explained in MPEP 2144.05 II. B, entitled "Only Result-Effective Variables Can Be Optimized"

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

The degree to which the powder rises above the surface is a variable never before recognized in the art as being results effective. This is obvious when one considers that extruded powders have never been used in the manner that the applicant is claiming. With applicant's invention, an applicator brush is drawn in one motion, without lifting the brush, across several extruded powders. Neither extruded

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powders nor pressed powder compacts are ordinarily used in this way. With a pressed powder compact, a brush is moved over one color in the compact case and then applied to the skin. When mixing colors is desired a brush is moved over one color in the compact case, then the brush is lifted and placed on a second color in the case and then applied to the skin. Alternatively, the color mixing is done on the skin by applying the powders in succession. In either case, it is not all typical to draw the applicator across different powders in one motion, without lifting. **Because of this fact**, the powders in pressed powder compacts do not ordinarily rise above the surface in question. Generally, having the powder rise above the pan surface is not desirable because the powder is less protected and more likely to break off in the case, making a mess. Pans are typically sized so that the surface of the powder is below the top of the pan. For this reason, an ordinary person of skill in the art would not recognize the degree to which the powder rises above the surface as a results effective variable. Powder above the surface is not ordinarily desired. And even if it was, that pertains to pressed powders and not to extruded powders, which have never been used in this manner before. Prior to applicant's invention a person of ordinary skill in the art would not understand the meaning of the degree to which an extruded powder rises above the surface of the case, because extruded powders were never reposed in this type of case, as the applicant has done. It must now be admitted that the degree to which the extruded powder rises above the surface is not recognized in the art as a results effective variable and therefore, a person of ordinary skill in the art could never be expected to come to the value of 40% by routine experimentation. The value of 40% is newly disclosed as a results effective amount in the applicant's disclosure. Reconsideration of the rejection of claim 9 is requested.

C. Claims 20-25 stand rejected as being unpatentable over Israel et al in view of Gueret (US 5,713,471). Once again the Examiner has erroneously relied upon the notion that Israel anticipates applicant's claim 1, from which depend claims 20-25. On that inappropriate foundation, the Examiner attempts to build an obviousness rejection. However, since claim 1 is not anticipated by Israel, this rejection cannot stand. Furthermore, claim 1 is not rendered obvious by the combination of Israel and Gueret because neither reference discloses extruded powders let alone extruded powders

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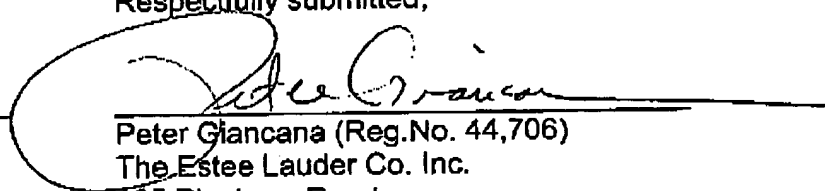
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disposed in grooves. Since claims 20-25 depend from a non-obvious claim, they too must be non-obvious.

All rejections having been addressed, allowance of all pending claims is requested.

Respectfully submitted,

Dated: Nov 21, 2003



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